

Remarks/Arguments

1. Introduction

Applicants note with appreciation the finding of allowability of claims 15-19, as well as the finding of allowable subject matter in claims 5, 12, 21 and 24-28. However, Applicants choose to pursue prosecution of the remaining claims.

2. Amendments to the Specification

The written specification has been amended to overcome typographical errors. In addition, Applicants have amended paragraph [0034] to include the inherent formula of silsesquixanes as would be understood by a person of ordinary skill in the chemical arts. See Declaration of Frank Xu @ ¶ 5, attached hereto. As a result, Applicants contend that no new subject matter has been introduced by these amendments.

3. Amendments to the Claims

A. Objection to Claim 15

In the Office action, claim 15 was objected to due to the misspelling of the term hexamethoxymethylmelamine. Appropriate amendments have been made. Applicants believe that claim 15 now comports with the practices and procedures of the United States Patent and Trademark Office. No new subject matter has been introduced by these amendments.

B. 35 U.S.C. § 112, first paragraph

In the Office action claims 6 and 24 were rejected as allegedly failing to comply with the enablement requirement. Applicants have made appropriate amendments to claims 6 and 24. Applicants contend, therefore, that claims 6 and 24 comport with the provisions of 35 USC section 112, first paragraph. None of

the amendments made to these claims were necessitated by material information, prior art or otherwise. No new subject matter has been introduced by these amendments.

C. 35 U.S.C. § 112, second paragraph

In the Office action claims 1-14 and 20-28 were rejected pursuant 35 USC section 112, second paragraph as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter that the Applicants regard as the invention. Appropriate amendments have been made to claims 1 and 20. Applicants contend, therefore, that the amended claims comport with the provisions of 35 USC section 112, second paragraph.

D. Rejection Pursuant 35 U.S.C. § 102

In the Office action, specified claims were rejected pursuant to 102(e) as allegedly being anticipated by Fang et al., U.S. patent application publication number 2004/0202872 and pursuant to 102(b) as allegedly being anticipated by Lockhart et al., United States patent number 4,517,337. Applicants have amended claims 1 and 20 to more clearly distinguish the present invention from the cited prior art. Specifically, claim 1 defines a composition as including, *inter alia*, a composition including a silicone resin component having a formula $\text{RSiO}_{1.5}$, an aminoplast cross-linking component, an acidic catalyst component, and a solvent component. Claim 20 defines a composition as including, *inter alia*, a composition including a solid silicon-containing component, an aminoplast cross-linking component, an acidic catalyst component, and a solvent component.

None of the cited prior art teaches Applicants' solid silicon-containing component. Included within the genus of solid silicon-containing component are silicone resins and silsequioxanes. See Declaration of Frank Xu @ ¶ 6.

Silsequioxanes are known to one of ordinary skill in the art to have a general repeating unit with a formula: $\text{RSiO}_{1.5}$. See *id.* Each of the aforementioned chemical species is characterized by having a mono-organo siloxane structures. See *id.* As a result of the mono-organo siloxane structure, the silicon-containing component is solid. This differs from the diorgano siloxane components of the cited prior art, which are fluids. See *id.* As stated throughout Fang et al, the compositions taught therein are the product of a silicone fluid and a solvent. See ¶ [0014]. An exhaustive listing of the compositions is recited in ¶ [0021] and Applicants have not identified one composition that includes Applicants' claimed mono-organo siloxane structure.

Applicants, on the other hand, have created a composition for use in the semiconductor processing industry, among others. See ¶ [0002]. It is well known that out-gassing is an undesirable characteristic of layers formed during semiconductor processes. Considering that the present composition is intended for use as a masking layer in lithographic processes, it is designed with components demonstrating minimal out-gassing characteristics. See Declaration of Frank Xu @ ¶ 6. To that end, solid silicon-containing components are employed in the compositions.

On the other hand, Fang et al.'s composition is employed to coat substrates not employed in semiconductor processing, e.g., windshields for automobiles. See ¶ [0036]. As a result, Fang et al. did not recognize Applicants' problem, thereby precluding any suggestion of Applicants' claimed invention. See *In re Spinnoble*, 160 USPQ 237 (CCPA 1969) (finding that is well established that an invention having an otherwise obvious structure is subject to patent protection if it overcomes a known problem, the source of which the art had not previously recognized), see also, *In re Nomiya*, 184 USPQ 607, 612 (CCPA

1975) (holding that where the prior art fails to recognize the problem at all, the claimed invention may be deemed patentable).

Moreover, Lockhart et al. do not overcome the deficiencies of Fang et al. Lockhart et al. direct their invention to room temperature vulcanizable of organopolysiloxanes. Lockhart et al. would not recognize the desire to avoid outgassing characteristics in silicon-containing compositions. As a result, Lockhart advocates a composition including a liquid silicon-containing component, such as polydimethylsiloxane. Based upon the foregoing, Applicants respectfully contend that the cited prior art does not anticipate nor render obvious the invention defined by amended claims 1 and 20.

E. The Non-obviousness of the Dependent Claims

Considering that the dependent claims include all of the features of the independent claims from which they depend, these claims are patentable to the extent that the independent claims are patentable. Therefore, Applicants respectfully contend that the dependent claims defined system suitable for patent protection.

4. Information Disclosure Statement

Applicants share the Examiner's frustration with respect to the Information Disclosure Statements. The references cited by the Examiner, however, clearly demonstrate the difficulties of the situation. First the Manual of Patent Examining Procedure is not binding on whether the duty of disclosure is satisfied. Furthermore, neither the District Court case nor the Fifth Circuit Court of Appeals case are controlling on the duty of disclosure. The one case cited as *Molins PLC v. Textron, Inc.*, 48 F.3d 1172 (Fed Cir. 1995), however, is clearly controlling. The rule set forth in *Molins* is that "[i]nformation is 'material' when there is a substantial likelihood that a reasonable examiner

would have considered the information important in deciding whether to allow the application to issue as a patent." *Id.* at 1179. Nonetheless, it behooves Applicants to proceed with caution and provide copies when in doubt. To that end, an exhaustive list of references cited in related patent applications have been included in the present application. However, it appears that several of the references were not considered. Particularly, references associated with cite numbers A368, A369, A370, A371, A372, A373, A374, A375, A376, A390, A391, A392, A393, A394, A395, A396, A397, A398, A445, A446, A447, A448, A449, A450, A451, A452 and A453 have not been initialled on the 1449B/SB08 Form. Moreover, there is no indication in the Office action as to why these references were not considered. Applicants contend that the same have been previously provided to the Examiner. Nonetheless, it appears, that the references associated with the aforementioned cite numbers are less pertinent than the prior art being considered by the Examiner. Nonetheless, Applicants request that the same be considered.

Applicants respectfully request examination in view of the remarks. A notice of allowance is earnestly solicited.

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